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BAYER CORPORATION
100 BAYER ROAD
PITTSBURGH, PA 15205-9741

EXAMINER

WOOD, ELIZABETH D

ART UNIT	PAPER NUMBER
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1755

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Please find below and/or attached an Office communication concerning this application or proceeding.



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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Paper No. 10

Application Number: 09/582,141
Filing Date: June 21, 2000
Appellant(s): HOFMANN ET AL.

Carolyn M. Sloane
For Appellant

EXAMINER'S ANSWER

MAILED

JUN 28 2002

GROUP 1700

This is in response to the appeal brief filed May 15, 2002.

(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) Status of Claims

The statement of the status of the claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellants' statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Invention

The summary of invention contained in the brief is correct.

(6) Issues

The appellants' statement of the issues in the brief is substantially correct. The changes are as follows: The rejection of claim 9 under 35 USC 112 is hereby withdrawn. The rejection of claims 1-7 and 9 under 35 USC 102(e) is hereby withdrawn. Accordingly, the only issue to be resolved is the rejection of claims 1-7 and 9 under 35 USC 103(a) as obvious in view of U.S. Patent No. 5,714,428 to Le-Khac.

(7) Grouping of Claims

The appellants' statement in the brief that certain claims do not stand or fall together is not agreed with because the rejections under 35 USC 112 and 35 USC 102(e) have been withdrawn. Only the rejection of claims 1-7 and 9 under 35 USC 103(a) remains, and the brief does not argue the claims separately with respect to the remaining ground of rejection. Accordingly, claims 1-7 and 9 are considered to stand or fall together.

(8) Claims Appealed

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) Prior Art of Record

5,714,428

Le-Khac

2-1998

(10) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to

consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1-7 and 9 are rejected under 35 U.S.C. 103(a) as obvious over U.S. Patent No 5,714,428 to Le-Khac.

This application involves a double metal cyanide catalyst, method for the production thereof and method for the use thereof. The groups will be addressed together because it would appear that applicants consider the novelty of all embodiments of the invention to reside in the addition of a polycarbonate to the DMC catalyst composition.

Le-Khac discloses a DMC catalyst composition containing about 2 to about 80% of a functionalized polymer. The polymer can be a polycarbonate. This is substantially representative of the invention as claimed in the instant application. See particularly columns 4 and 5.

The Le-Khac disclosure can be considered to "differ" from the herein claimed invention in scope, i.e. Le-Khac discloses many other functionalized polymers not within the scope of the instant claims. However, the instant claims would have been obvious because it would have been within the skill of the practicing artisan to select one of the possibilities specifically disclosed by the reference. The reference further discloses benefits associated with the select of these functionalized polymers, namely higher activity. The skilled artisan would expect that all specifically disclosed functionalized polymers would provide such benefit and would therefore be motivated to select any of these polymers. The motivation is clearly provided by the prior art itself.

(11) Response to Argument

The examiner considers that appellants' arguments can be summarized by the following questions:

1) Would the skilled artisan find the requisite motivation within the Le-Khac document to select the claimed polycarbonate in the claimed amount as a component of a DMC containing catalyst?

2) Would this selection require undue experimentation since Le-Khac does not exemplify a polycarbonate?

3) Assuming arguendo that 1 and 2 above are correct, do the unexpected results found in the instant specification overcome the prima facie case of obviousness set forth hereinabove?

The examiner will consider the above questions in the same order as summarized above:

1) The Le-Khac disclosure itself provides the motivation for the selection of a polycarbonate in an amount of 2 to 80 weight percent. The Le-Khac disclosure specifically recites use of a polycarbonate component in line 1 of column 5 and the carbonate is one of only nine polymers being recited as "preferred catalysts of the invention". The Le-Khac disclosure also teaches the polymer to be used in an amount of about 2 to about 80 weight percent, the same amount being claimed in the instant application. Accordingly, the reference disclosure is considered to provide the requisite motivation for selection of a polycarbonate in the claimed amount as a component in a DMC containing catalyst.

2) The selection of a polycarbonate from the list of functionalized polymers provided by Le-Khac would not require undue experimentation because Le-Khac discloses polycarbonate as one of only nine preferred species.


3) The unexpected results in the specification have been carefully considered. As discussed by appellants in the brief, the polycarbonate containing DMC catalyst shows a substantially decreased induction period compared to a polypropylene glycol containing DMC catalyst. However, this is not considered to be a showing against the **closest prior art of record**. The closest prior art is the Le-Khac document being relied upon for the rejection. Accordingly, a showing against one of the other "preferred catalysts" of the Le-Khac document would have significantly more probative value than a showing against polypropylene glycol which is **not** one of the preferred components in the catalysts of the closest prior art of record. As a result, the examiner maintains the position that the evidence of obviousness outweighs the evidence of unexpected results set forth in the examples of the instant specification.

Application/Control Number: 09/582,141

Page 7

Art Unit: 1755

Respectfully submitted,


Elizabeth D. Wood

Primary Examiner
Art Unit 1755

EDW

June 24, 2002

Conferees

Mark Beli

Steve Griffin




BAYER CORPORATION

100 BAYER ROAD

PITTSBURGH, PA 15205-9741